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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,504	10/07/2004	Yuuji Gotou	121342	7327

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/510,504

Applicant(s)

GOTOU ET AL.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 15,17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. PCT/JP03/03639.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Foreign Reference.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-14 and 16 in the reply filed on March 9, 2006 is acknowledged. The traversal is on the ground(s) that the entire application could be searched without an undue burden of the examiner. This is not found persuasive because each group lacks the same or corresponding special technical features and the search for any one group would be an entirely different search than that for any other group. It would therefore clearly be an undue burden on the examiner to search all of the groups together.

The requirement is still deemed proper and is therefore made FINAL.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/JP03/03639, filed on March 25, 2003.

Drawings

The drawings received October 7, 2004 are objected to because Figure 6A should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified

and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 1, 7, and 16 (and dependent claims 2-6 and 8-14) are objected to for the following reasons. Since the intended meaning could be determined from what is set forth in the specification and claims, 112 rejections were not made but instead these lack of clarity issues are being raised in the following objections.

With respect to claims 1 and 16, in claim 1, line 14 and claim 16, line 15, "of at least a peripheral portion in the peripheral zone is identical" should be corrected to "of at least a peripheral portion in the front peripheral zone is identical" to provide additional clarity to the assumed meaning from what is set forth in other portions of the claim and within the specification.

With respect to claim 7, line 10, that part of the claim stating "the first front surface peripheral zone forming the first peripheral zone" creates a lack of clarity since the first peripheral zone is formed by both the first front surface peripheral zone and the back surface. It is suggested that in line 10, applicant delete "forming the first peripheral zone" to provide additional clarity.

Claim Rejections - 35 USC § 112

Claims 1 and 11-13 (and dependent claims 2-10 and 14) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, claiming "having a given diameter dimension" and then in claim 2 claiming that the diameter is varied and in claim 3 claiming a range of diameters renders the claim vague and indefinite. It is not clear if in claim 1 applicant means that each lens within the series has the same diameter or have a range of diameters or if some other meaning is intended and the lack of clarity renders the claim vague and indefinite. For purpose of examination, and based upon what is claimed in claims 2 and 3, in claim 1, the assumed meaning of "having a given diameter dimension" is "having a given range of diameter dimensions".

Specifically, in reference to claim 11-13, the claimed "a molding material" and "the molding material" creates a lack of clarity since claim 1, from which these claims depend have not claimed that the lens or a portion of the lens is formed by molding. It is therefore not clear if applicant intended to claim a portion of the lens formed by molding and if so what specific portion and the lack of clarity renders the claims vague and indefinite. If molding or a specific portion formed by molding is intended as a limitation then it needs to be more positively and distinctly claimed. For purposes of examination the assumed meaning is "wherein at least a portion of said contact lenses are formed by molding".

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7, 14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese document number 63-3910 (herein referred to as "Japanese'910").

Japanese'910 discloses the limitations therein including the following: a series of contact lenses (English abstract and any two of such lenses can be considered as a "series of lenses"); each comprising a central optical zone and a peripheral zone (English abstract, entire document and Figures 1, 3, 5); each of the central optical zone and peripheral zone having a front surface and a back surface (Figures 1, 3, 5). Any two lenses of Japanese'910 will inherently have a range of diameter dimensions (the assumed meaning i.e. any two lenses will inherently have a given diameter and therefore between the two there will inherently be a range of diameter dimension). Japanese'910 further discloses that the optical zone between two lenses will be different (English abstract, entire document which discloses that the front surface central optical zone will be machined and therefore the central optical zone will differ between lenses); a shape of the lens back surface the same for each lens (English abstract, entire document which discloses the concave surface formed by molding and not machined and therefore the concave surface will be the same for any two lenses); an area extending a predetermined width in a diametrical direction of a peripheral

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portion of the front surface the same for each lens (English abstract, entire document which discloses the front surface formed by molding and the front central portion only being machined therefore since the front surface peripheral portion is not being machined it will be the same for any two lenses); and the shape of the front surface optical zone different among lenses to provide different optical characteristics (English abstract, entire document which discloses the front central portion being machined and therefore the central optical zone will differ between lenses). It is believed that at least any two lenses of Japanese'910 will inherently have a diameter within the range of claim 3, a center portion thickness varied based upon power, a center portion thickness within the range of claim 5, a power within the range of claim 6, and at least two lenses with a difference in power of at least 5 diopters, this being reasonably based upon the large ranges claimed as well as upon the similarity in structure to that of the claimed invention. Japanese'910 further discloses a back surface peripheral zone having a curved surface with a radius of curvature greater than the back surface optical zone (see figures 1 and 5); and the entire back surface and at least a portion of the outer peripheral front surface formed by molding (English abstract, entire document). With respect to claim 7, the innermost peripheral portion of Figures 1, 3, and 5 could be considered the "first peripheral zone" and the outermost peripheral portion of Figures 1, 3 and 5 could be considered the "second peripheral zone". Since Jp-910 discloses that none of the peripheral zone is machined as stated above, then the entire peripheral zone including the second peripheral zone among lenses will be of identical shape. Jp'910 further discloses a smooth surface connecting the inner portion of the peripheral

zone (the "first peripheral zone") to the central optical zone and the outer peripheral zone in a diametrical dimension (Figures 1 and 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese'910 in view of Schlueter et al patent number 6,806,337.

Japanese'910 discloses as is set forth above and the peripheral zone of the contact lens of Japanese'910 will inherently have a thickness within the range of claim 12, this being reasonably based upon the large range claimed and the similarity in structure to that of the claimed invention. Japanese'910 discloses as is set forth above but does not specifically disclose a silicone molding material or a Young's modulus within the range of claim 12. Schlueter et al teaches that in contact lenses it is desirable to have the lenses formed of a silicone material or to have a Young's modulus within the claimed range for the purpose of providing an ophthalmic lens that is soft and has improved strength (column 1, lines 8-29, column 2, lines 44-54, Table 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lenses of Japanese'910 formed of a silicone material or having a Young's modulus within the claimed range since Schlueter et al teaches of

these features within contact lenses for the purpose of providing soft contact lenses of improved strength.

Prior Art Citations

Barkdoll et al is being cited herein to show a contact lens having some similar features to that of the claimed invention.

Allowable Subject Matter

Claims 2, 8-10 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with respect to claim 2, none of the prior art either alone or in combination disclose or teach of the claimed series of contact lenses specifically including, as the distinguishing feature in combination with the other limitations, the claimed diameter of the front surface optical zone varied depending on differences in refractive power of the optical zones. Specifically, with respect to claims 8, none of the prior art either alone or in combination disclose or teach of the claimed series of contact lenses specifically including, as the distinguishing feature in combination with the other limitations, the claimed first front surface peripheral zone represented by a cubic curve in the diametrical direction. Specifically, with respect to claims 9-10, none of the prior art either alone or in combination disclose or teach of the claimed series of contact lenses

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specifically including, as the distinguishing feature in combination with the other limitations, the claimed diameter of the front surface optical zone smaller than the diameter of the back surface optical zone with the back surface optical zone offset as claimed. Specifically, with respect to claim 13, none of the prior art either alone or in combination disclose or teach of the claimed series of contact lenses specifically including, as the distinguishing features in combination with the other limitations, the Young's modulus and average thicknesses within the claimed ranges.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:30 to 4:30).

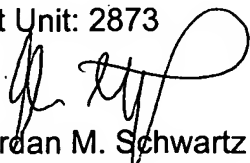
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached at (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Jordan M. Schwartz', written over the printed name.

Jordan M. Schwartz

Primary Examiner

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March 29, 2006